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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Toth, Thomas L.
Serial No. : 10/063,366
Filed : April 16, 2002
For : Method and Apparatus of Multi-Energy Imaging
Group Art No. : 3737
Examiner : Baisakhi Roy

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CERTIFICATION UNDER 37 CFR 1.8(a) and 1.10

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments have been made with this request. The request is being filed with a Notice of Appeal. The review is requested for the reasons set forth hereinafter.

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REMARKS

Claims 1-27 are pending in the present application. In the Final Office Action mailed April 24, 2006, the Examiner rejected claims 1-4, 8-12, 16-21, and 24-27 under 35 U.S.C. §102(b) as being anticipated by Gordon, et al. (USP 5,661,774). The Examiner next rejected claims 5, 13, and 22 under 35 U.S.C. §103(a) as being unpatentable over Gordon, et al., in view of Heuscher (USP 5,262,946). Claims 6-7, 14-15, and 23 have been withdrawn from consideration as being directed to a non-elected species.

In the Amendment/Response filed June 26, 2006, Applicant made note of the file history for this application. In the Restriction Requirement of April 11, 2005, the Examiner alleged that the application contained claims to three patentably distinct species:

species drawn to obtaining CT images of a *medical patient*;
species drawn to obtaining CT images of *luggage*; and
species drawn to obtaining CT images of *postal packages*.

In response, on May 3, 2005, Applicant elected the "species drawn to obtaining CT images of a medical patient" corresponding to claims 1-4, 8-12, 16-21, and 24-27. After an Office Action dated July 12, 2005 and a response dated August 4, 2005, a Notice of Allowance was mailed on October 24, 2005. The issue fee was paid on November 15, 2005. Issuance was subsequently vacated on December 14, 2005, *by citing art pertaining to one of the non-elected species*, against claims 1-4, 8-12, 16-21, and 24-27 of the elected species. The cited prior art, Gordon, et al., discloses, in part, a "*baggage scanning assembly* [that] includes a CT scanning system, and a conveyor belt for transporting items through the CT scanning system, and an improved power supply for the X-ray source of the CT scanner." *Gordon, et al., Abstract (emphasis added)*. As stated above, the Examiner asserted that obtaining CT images from a medical patient and obtaining CT images from luggage are patentably distinct species. However, in the Final Office Action mailed April 24, 2006, and in the Advisory Action mailed July 14, 2006, the Examiner still maintains the species restriction.

Applicant is confused how prior art pertaining to a non-elected species (a baggage scanner) anticipates claims of the elected species (a medical imaging scanner) when the Examiner deems such as being patentably distinct. It is inconsistent for the Examiner to assert that the elected species drawn to obtaining CT images of a medical patient is patentably distinct from the non-elected species drawn to obtaining CT images of luggage, while simultaneously asserting a reference pertaining to the non-elected species against claims of the elected species. As such, Applicant requested withdrawal of the rejection of claims 1-4, 8-12, 16-21, and 24-27 under 35

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U.S.C. §102(b) as being anticipated by Gordon, et al., which pertains to a species that the Examiner has identified as patentably distinct therefrom. Either the rejection or the restriction requirement must be withdrawn.

Notwithstanding that Gordon, et al. pertains to a non-elected species, the Examiner rejected claim 1 under 35 U.S.C. §102(b) as being anticipated by Gordon, et al. Applicant respectfully disagrees. Claim 1 calls for, in part, a CT system comprising a gantry, an energy source, a generator, and a hub, wherein a number of HF electromagnetic energy filters are in a spoked relationship with the hub, wherein a first filter is positioned between the HF electromagnetic energy source and the subject by rotation of the hub and a second filter is positioned between the HF electromagnetic energy source and the subject by rotation of the hub.

Gordon, et al. teaches a dual energy baggage scanner for detecting explosives in baggage. *Gordon, et al., Col. 1, Ins. 37-39.* Filter 262 in the baggage scanner is a *flat metal disk* with six pie shaped segments, with three of the segments 270 formed from relatively thick material, and three segments 272 formed from relatively thin material. *Gordon, et al., Col. 13, Ins. 23-33.* "Segments 270 and 272 are alternately disposed so that each of the thick segments 270 is adjacent to two of the thinner segments 272, and vice versa." *Gordon, et al., Col. 13, Ins. 37-39.* Filter 262 rotates to dispose segments 270 and 272 alternately in the beam. *Gordon, et al., Col. 13, Ins. 40-44.*

In the Advisory Action, the Examiner stated, with regard to the number of HF filters in the spoked relationship, that "the metal disk with the 'pie shaped' segments is equivalent to the claimed structure." (emphasis added) However, as stated in MPEP §2131, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP §2131 further requires that "[t]he identical invention [] be shown in as complete detail as is contained in the ... claim" and that "[t]he elements [] be arranged as required by the claim." The Examiner has mis-applied the law and, at best, an "equivalent" claim structure pertains to 35 U.S.C. §103. Anticipation under 35 U.S.C. §102 does not allow for equivalent claim structures.

With respect to the Examiner's statement that the claimed structures are "equivalent," Applicant's remarks in the following paragraph's are made, not to define the claims over the prior art, but to address the Examiner's conclusion that the cited 'pie shaped' segments of Gordon, et al. and that of the claimed structure are "equivalent." Notwithstanding the Examiner's mis-application of the law (i.e., that an "equivalent" can form the basis of a §102 rejection), Applicant believes the Examiner has erred in stating that the cited art and the claimed structure are

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equivalent. By advancing the following arguments, Applicant in no way acquiesces that the standard asserted (i.e. "equivalent" under 35 U.S.C. §102) by the Examiner is correct.

The claimed structure is not equivalent to that disclosed in Gordon, et al. Contrary to the Examiner's assertion, a metal disk with 'pie shaped' segments is not equivalent to the claimed structure, wherein the filters are in a spoked relationship with a hub. Gordon, et al. discloses a flat metal disk with six pie shaped segments formed in the disk, wherein the pie shaped segments alternate between thick and thin material in the adjacent pies. The flat metal disk of Gordon, et al. is not tantamount to a number of HF electromagnetic energy filters that are in a spoked relationship with a hub, wherein a first filter is positioned by rotation of the hub, and a second filter is positioned by rotation of the hub.

It is evident, when comparing the flat disk-filter of Gordon, et al., and the filtering apparatus of the Applicant, that both rotate about different axes of rotation, therefore they are not equivalent. While both filters may possess local and global axes of rotation. The local axis pertains to the filter's rotation of axis relative to its filtering surfaces, and the global axis pertains to placement of the filter onto an imaging system. In order to function as a filter, the plane of the filtering material is placed between, and substantially orthogonal to, a line between the x-ray source and the object to be imaged. As such, Applicant's Figs. 1 and 6 illustrate filtering apparatus 17, and placement of filtering apparatus 17 on imaging system 10 relative to x-ray source 14. Filtering apparatus 17 has filtering surfaces 90, 92, 94, and 96 that are substantially parallel with the local axis of rotation. As such, filtering apparatus 17, when positioned on imaging system 10, also rotates about a local axis of rotation, wherein the local axis of rotation is substantially parallel to the global axis of rotation of imaging system 10. That axis of rotation is also, for reference purposes, in line with the length of the patient illustrated.

The filter of Gordon, et al., on the other hand, clearly possesses, inherently, different local and global axes of rotation. The filter of Gordon, et al. has a rotational center that is substantially at the center of the disk. As such, its local rotational axis is perpendicular to the disk surfaces that serve to filter the x-ray beam. Furthermore, global placement of the disk of Gordon, et al. clearly precludes placement of the disk on the system with its rotational axis in line with rotational axis of the gantry. The filter of Gordon, et al. does not operate as a filter, as described, were it to be placed on a gantry using the same axis of rotation as that of Applicant.

In summary, Applicant respectfully disagrees that Gordon, et al. teaches a filter wherein "each and every element as set forth in the claim is found," wherein "[t]he identical invention [] be shown in as complete detail as is contained in the ... claim" and wherein "[t]he elements []

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[are] arranged as required by the claim.” Applicant respectfully submits that the Examiner has made an error in applying the law, and that MPEP §2131 does not allow for structural claim elements that are “equivalent.” Finally, Applicant disputes that the claimed structure is equivalent, if that were the standard, to Gordon et al., as such, that which is called for in claim 1 is not disclosed or suggested in the art of record. As such, Applicant believes claim 1, and the claims which depend therefrom, are patentably distinct over the art of record.

The Examiner next rejected claims 8, 16, 19, and 24 under 35 U.S.C. §102(b) as being anticipated by Gordon, et al. Claim 8 calls for, in part, positioning a first portion of a filtering apparatus in a spoked relationship with a hub, and positioning a second portion of the filtering apparatus in a spoked relationship with the hub. Claim 16 calls for, in part, positioning a first filter by rotation of a hub in a spoked relationship with the first filter, and positioning a second filter by rotation of the hub in a spoked relationship with the second filter. Claim 19 calls for, in part, rotating a hub to position a first filter, in a spoked relationship with the hub, and rotating the hub to position a second filter, in a spoked relationship with the hub, between the HF electromagnetic energy source and the subject. Claim 24 calls for, in part, a hub, a first filter connected to the hub at a first connection port, and a second filter connected to the hub at a second connection port, wherein the first and second filters are in a spoked relationship with the hub. As stated above, Gordon, et al. fails to teach a hub with a number of filters in a spoked relationship with the hub. Additionally, contrary to the Examiner’s assertion, a metal disk with ‘pie shaped’ segments is not equivalent to the claimed structure. As such, Gordon, et al. fails to disclose that which is called for in claims 8, 16, 19, and 24. As such, Applicant believes claims 8, 16, 19, and 24, and the claims which depend therefrom, are patentably distinct over the art of record.

The Examiner next rejected claims 5, 13, and 22 under 35 U.S.C. §103(a) as being unpatentable over Gordon, et al., in view of Heuscher. Applicant respectfully disagrees with the Examiner with respect to the art as applied, and in light of claims 5, 13, and 22 depending from what are believed otherwise allowable claims, the Applicant respectfully requests allowance of claims 5, 13, and 22 based on the chain of dependency.

Applicant believes that claims 1, 8, and 19 are generic and, as such, upon their allowance, claims 6-7, 14-15, and 23 should be rejoined.

Therefore, in light of at least the foregoing, Applicant respectfully believes that the present application is in condition for allowance. As a result, Applicant respectfully requests timely issuance of a Notice of Allowance for claims 1-27.

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Applicant appreciates the Examiner's consideration of these Amendments and Remarks and cordially invites the Examiner to call the undersigned, should the Examiner consider any matters unresolved.

Respectfully submitted,

/Timothy J. Ziolkowski/

Timothy J. Ziolkowski
Registration No. 38,368
Direct Dial 262-376-5139
tjz@zpspatents.com

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Attorney Docket No.: GEMS8081.102

P.O. ADDRESS:
Ziolkowski Patent Solutions Group, SC
14135 North Cedarburg Road
Mequon, WI 53097-1416
262-376-5170